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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,679	12/19/2000	J. Stuart Cumming	13533.4033	6074
34313 7590 01/30/2008 ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558			EXAMINER PREBILIC, PAUL B	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 01/30/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/740,679

Applicant(s)

CUMMING, J. STUART

Examiner

Paul B. Prebilit

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-102 and 104-124 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90, 91, 93-95, 99-102 and 104-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 58,60,62,64-71,75,76,78,79,81-84,87-89,92 and 96-98.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 28, 2007 has been entered.

Election/Restrictions

Claims 58, 60, 62, 64-71, 75, 76, 78, 79, 81-84, 87-89, 92, and 96-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 11, 2002. Claim 65 is dependent upon a withdrawn base claim so it is withdrawn even though the Applicant argued that it was drawn to the elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90-91, 93-95, 99-102, and 104-124 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new language "tangential grooves" lacks original support. The Applicant is reminded that an RCE cannot be used as a means to enter new matter only continuation filed under Rule 53 as continuation-in-part applications. It is noted that the language "tangential" is used on paragraphs 110 and 128 of the corresponding publication to this file but it is used in a different fashion and to different species to the presently elected species of Figure 18.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d) (1) and MPEP § 608.01(o). Correction of the following is required:

As an alternative to the Section 112, first paragraph rejection supra, the Examiner asserts that even if support was shown to be inherent to the original disclosure that the language "tangential" grooves and "linear grooves" would still lack antecedent basis from the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 53-57, 59, 61, 63, 72-74, 77, and 99-101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. On lines 8-9 of claim 53, the new language "separated from the optic with a linear groove across

each plate haptic” is confusing because “separated” refers back to the plate haptics. Therefore, it is unclear how the groove can both separate the haptic from the optic and be on the haptic as well. It may be that “plate haptic” in this excerpt was intended to be --lens body--- or “separated from the optic” was not appropriate language that could be deleted.

Claims 54, 63, 80 and 85 are objected to because of the following informalities: claim 63 has the same scope as claim 54 and claim 85 has the same scope as claim 80. Before allowance of the application, one of each of these pairs of claims will need to be cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80, 85, 86, 107, 110-115, and 117-124 are rejected under 35 U.S.C. 102(b) as being anticipated by Reuss et al (US 4,664,665). Reuss anticipates the claim language where:

- the optic as claimed is the primary portion of Reuss;
- a biconvex optic is taught on column 1, lines 32-39 and column 6, lines 51-60;
- the groove as claimed is groove (66) of Reuss;
- the haptic as claimed is secondary portion (34) or (36);

- the lens is capable of movement because it is foldable and has the same design as claimed; see Figures 1 to 10 and column 3, line 66 et seq.

Response to Amendment

The declaration under 37 CFR 1.132 filed December 28, 2007 is insufficient to overcome the rejection of the claims based upon Schlegel as set forth in the last Office action because:

- it is a presentation of an opinion only so it has little probative value;
- it is only valid against Section 103 rejections even though Schlegel was applied under Section 102, but the declaration does assert that the claim language is not met and the rejection of Schlegel has been withdrawn due to the amendments made to the claims;
- the declarant argues that Schlegel cannot bend at the haptics but offers no proof
- the Shore A hardness of 30 to 60 is relatively soft and the thickness of only 0.15 to 0.40 mm reasonably implies that the haptics are bendable under a small force.
- the declarant admits that the lens can flex in a cross direction so it would follow from this that the haptics can flex more easily being that they are thinner and made of the same material;
- the declarant argues that Schlegel intention was to produce a stable lens but what is important under Section 102 is what is actually disclosed and made by the prior art;

- the fact that Schlegel can utilize stiffeners suggests that the haptic is so flexible that stiffeners are needed to stabilize it so it is not as flexible.

The rejections based upon Schlegel have been withdrawn because of the claim amendments so the declaration is currently moot.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is, not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
Art Unit 3774